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EXAMINER

LIM, KRISNA

ART UNIT PAPER NUMBER

2153

DATE MAILED: 06/08/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

OR

# Office Action Summary

Application No.

09/625,646

Applicant(s)

TANNENBAUM, DAVID H.

Examiner

Krisna Lim

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004 and 01 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26, 44-51, 61-67, 69, 70, 75-78, 81-85 and 97-118 is/are pending in the application.
- 4a) Of the above claim(s) 104-118 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26, 44-51, 61-67, 69-70, 75-78, 81-85 and 97-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. Claims 1-26, 44-51, 61-67, 69-70, 75-78, 81-85, and 97-103 are pending for examination and claims 97-118 just added for examination. Claims 27-43, 52-60, 68, 71-74, 79-80 and 86-96 were canceled.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26, 44-51, 61-67, 69-70, 75-78, 81-85 and 97-103, drawn to a system and a method for delivering information to a requesting user, comprising the means and steps of: a) recording a requesting from a user pertaining to information content desired by the user; b) accessing the recorded request by any information provider; c) determining by the accessing information provider whether or not the information said accessing provider has control of matches the information content requesting by the user, classified in class 707, subclass 1.

II. Claims 104-118, drawn to a method for allowing a user to purchase (merchandise) ticket over an interactive network (Internet) comprising: a) posting from a time to time at a site on said interactive network a description of ticket ...; b) matching by a party other than said posting user any said posted ticket description with tickets to events as said tickets become available, classified in class 705, subclass 26.

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a system and a method for delivering information to a requesting user lacks the steps of: a) posting from a time to time at a site on said interactive network a description of ticket ...; b) matching by a party other than said posting user any said posted ticket description with tickets to events as said tickets become available. See MPEP § 806.05(d).

Art Unit: 2153

4. Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a method for allowing a user to purchase (merchandise) ticket over an interactive network (Internet) lacks the steps of: a) recording a requesting from a user pertaining to information content desired by the user; b) accessing the recorded request by any information provider; c) determining by the accessing information provider whether or not the information said accessing provider has control of matches the information content requesting by the user. See MPEP § 806.05(d).

5. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose.

6. For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) the Group I search (claims 1-26, 44-51, 61-67, 69-70, 75-78, 81-85) would require use of search class 707, subclass 1 ( which would not required for the group II).

(b) the Group II search ( 104-118) would require use of search class 705, subclass 26 (which would not required for the group I).

**Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 71-75 and 81-95 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. And, claims 104-118 are being examined.**

7. Claims 1-26, 44-51, 61-67, 69-70, 75-78, 81-85 and 97-103 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Frauenhofer et al. [U.S. Patent No. 6,236,991] in view of Herz et al. [U.S. Patent No. 5,754,939].

8. Frauenhofer et al. disclosed (e.g., see Figs. 1-2) the invention substantially as claimed. Taking claims 1, 75 and 78 as exemplary claims, the reference disclosed a method for delivering information to a requesting user (e.g., see the abstract, col. 2, lines 9-10), the method comprising the steps of:

a) recording a request from a user pertaining to information content desired by said user (e.g., “collecting and categorizing customized user profiles” see the abstract, “creating a user profile”, see col. 2 (lines 25 and 66-67), col. 3 (line 5), col. 5 (line 8), col. 6 (line 38));

b) accessing the recorded request by any information provider (sources 11, content providers 12, “actively collect and categorize ... content for delivery ...”, see the abstract, col. 2, lines 1-27); and

c) determining by said accessing information provider whether or not the information said accessing provider has control of matches the information content requested by the user (matching and delivering categorized information to customized user profiles, see the abstract, col. 2, col. 3, line 15, and col. 6, lines 55-59).

9. While Frauenhofer disclosed the invention as mentioned above, Frauenhofer did not explicitly mention the exact term or phrase as claimed language. For example, while Frauenhofer disclosed the step of collecting and categorizing customized user profiles, Frauenhofer did not call this step as the step of “recording a request from a user pertaining to information content desired by the user.” It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that in the step of collecting and categorizing customized user profiles obviously contains the feature of recording (e.g., collecting and categorizing) because in order to categorize user profiles the step of recording must be performed.

Art Unit: 2153

10. As to claim 2, Frauenhofer et al. disclosed the feature of using the Internet for accessing information (e.g., see Figs. 1-2). Moreover, this feature was also taught by Hertz et al. (e.g., see Figs. 1-2, col. 79, lines 5-6).

11. Since both of these two references are directed toward to the method and the system for delivering information to a requesting user based on a user profile or a user interest, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Herz's system into Frauenhofer's system in order to enhance Frauenhofer's system with additional features of Herz's for delivering information to a requesting user based on a user profile.

12. As to claim 3, Frauenhofer et al. disclosed the feature of connection from the provider (content provider 12) directly to the user (16) (see Fig. 1). Moreover, this feature was also taught by Hertz et al. (e.g., see step 1600 of Fig. 16)

13. As to claim 4, Frauenhofer et al. disclosed the feature of user information to control the accessing of such request by third party (different restriction for user access, col. 5, lines 15-16). Moreover, this feature was also taught by Hertz et al. (e.g., see last 3 lines of the abstract).

14. As to claim 5, Frauenhofer et al. disclosed under at least partial control of the determining step delivering the information desired by the user (provision of the matched documents for the end user review, col. 5 (lines 11-12)).

15. As to claim 6, Frauenhofer et al. disclosed the feature of interacting between the accessing provider and the user as to the nature of the information to be delivered (e.g., see col. 5, line 14).

16. As to claims 7-19, while Herz et al. disclosed the user's profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to each user so that the user can select from among these potentially relevant target objects ...., Herz et al. however, did not explicitly detail the time of delivery, types of media for delivery, content of delivery, location of delivery, location of the user, location of a provider, payment information, follow up after delivery, respective obligation requirement, comparing access permissions, etc. It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that such detail features would have been a matter of programming choices because they are directed to the time, the type, the content, the location, etc. and therefore these features are not patentably distinguishable features.

17. As to claims 76 and 77, the use of e-mail message and wireless communication as a means for communicate among devices or users in a communication network are well known features in the art at the time the invention was made.

18. Claims 20-26, 44-51, 61-67, 69-70, 81-85 and 97-103 are similar in scope as of claims 1-19 and 75-78, and therefore claims 20-26, 44-51, 61-67, 69-70, 81-85 and 97-103 are rejected for the same reasons set forth above for claims 1-19 and 75-78.

19. The rejections are respectfully maintained as set forth in the last office action.

20. Applicant's arguments filed 2/5/04 and 4/1/04 have been fully considered but they are not deemed to be persuasive.

In the remarks, applicants argued that:

a) The inventive concept is directed to the user asking for specific information, not broad concepts, as would occur with the profiles of the Frauenhofer and Herz references. In reply, to the extent of the claimed language 1, Frauenhofer disclosed the feature as claimed (see paragraph 8 above).

b) Nothing in Frauenhofer even hints of a system or method where the information provider (the source or content providers of Frauenhofer) "accesses said recorded request". The Examiner has not addressed this aspect of the claim. In reply, Frauenhofer disclosed this feature (e.g., see col. 1, line 64, to col. 2, line 27).

c) In the Frauenhofer reference, the user's agent, as discussed above, is Server 10. The claimed invention turns this around and it is the provider who searches for a user. Thus, clearly, claim 1 is directed to the reverse of the cited reference. As noted above, the Examiner has not addressed such a reversed operation. In reply, to the extent of the claimed language, Examiner fails to see the feature of a provider who searches for a user.

d) The Herz reference is directed to the establishment of user profiles .... The Herz reference is not directed to how the information is delivered to the user and thus, Herz does not teach or suggest that the information provider controls the information flow. In reply, this is nothing more just attacking the reference individually.

e) In the Frauenhofer reference the local server (System Server 10), not the information source, matches the collected data against all of the profiles ... Clearly then in Frauenhofer it is the customer (or user) which does the matching. The accessing provider makes no determination as specifically called for in claim 1. In reply, Examiner respectively disagrees that the user who does the matching (e.g., see col. 3, lines 12-19).

f) In claim 2, the differences in language between the claims and the Frauenhofer reference yield a different operation, i.e., a reversed operation. Thus, neither Frauenhofer nor Herz disclose the "gist" of the invention. It is language, and only language, that defines inventive concepts. Thus, for the Examiner to acknowledge that the language is different, but still reject the claims (even when the language yields a reverse operation) without at least discussing how the different in language yields the same concept, is not a proper reject of the claim. In reply, see paragraph 9 for the rejection.

g) In claim 3, in both the Frauenhofer and Herz reference, it is the server who goes out for the information. Claim 3 contemplates that it is the supplier that goes after



the user and establishes the connection. In Frauenhofer, the user establishes the connection to the provider ... This is a concept reverse from that taught by Frauenhofer and Herz. In reply, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that such reverse concept would have been a matter of design choice.

h) In claim 6, Frauenhofer does not discuss interacting between the server and information resources in any manner and specifically not "as to the nature of the information to be delivered" as specifically recited in claim 6. Frauenhofer does not show any interaction between client 11 (12) and user 16. It is Server 10 (or possibly Server 14) which controls the information flow of the Frauenhofer system, not the information provider, as specifically claimed. In reply, in col. 5, lines 14-15, Frauenhofer disclosed different user interfaces with different interaction means. Thus, it would have been obvious to one of ordinary skill in the art to recognize that such different user interfaces with different interaction means would have been obviously use for interacting with different devices while the specific devices would have been obviously a matter of use or choice.

i) In claims 7-19, they are directed to a variety of different combinations and concepts, many of which the Examiner did not address. Therefore, calling them a "programming choice" is not a proper rejection. In reply, as mentioned in paragraph 16 above, It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that such detail features would have been a matter of programming choices because they are directed to the time, the type, the content, the location, etc. and therefore these features are not patentably distinguishable features.

j) Claim 76 is directed to sending an e-mail message that information is available. Neither the Frauenhofer nor the Herz references send email messages to alert a user that information available. In reply, the use of e-mail message to alert a user is the well known feature in the art at the time the invention was made

k) Claim 77 is directed to sending a wireless message that information is available. Neither the Frauenhofer nor the Herz references send wireless message to

alert a user that information is available. In reply, the use of wireless message to alert a user is the well known feature in the art at the time the invention was made.

I) In claim 44, the user inputs the abstract and the information source accesses the profile, and it is the information provider which controls the transaction and not the user. Thus, these elements are not taught by the cited references. In reply, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that such reverse operations between the information provider and the user would have been a matter of design choice.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Krisna Lim whose telephone number is (703) 305-9672. The examiner can normally be reached on Monday-Friday from 7:30 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenton Burgess, can be reached at (703) 305-4772. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [glen.burgess@uspto.gov].

All Internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Office Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

kl

June 4, 2004



KRISNA LIM  
PRIMARY EXAMINER